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OFFICE OF PETITIONS

In re Patent No. 7,044,458 :
Daily et al. : DECISION ON REQUEST
Issue Date: May 16, 2006 : FOR
Application No. 09/846,141 : RECONSIDERATION OF
Filed: April 30, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. 4660/5200 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705(d)," filed July 19, 2006. Patentees request that the patent term adjustment indicated on the face of the Letters Patent be corrected from six hundred seventy-eight (678) days to one thousand five (1005) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On May 16, 2006, the above-identified application matured into U.S. Patent No. 7,044,458, with a revised Patent Term Adjustment of 678 days. The instant request for reconsideration filed July 19, 2006 (certificate of mailing dated July 14, 2006) was timely filed within 2 months of the date the patent issued. See § 1.705(d). Patentees assert that additional periods of adjustment should have been entered for Office delay in issuing the patent more than four months after payment of the issue fee

and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent.

Patentees are incorrect with respect to correction being required for the date entered for their filing of the Issue Fee payment. In this regard, patentees' attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). The Issue Fee payment was received in the Office on March 17, 2006 (with a certificate of mailing dated March 15, 2006). For purposes of calculating PTA, the date of March 17, 2006 was properly used. Regardless, the patent issued on May 16, 2006, within four months of both dates. There was no Office delay within the meaning of § 1.703(a)(6).

With respect to §1.703(b), a review of the record confirms that an additional period of 54 days was entered for Office delay in issuing the patent. Furthermore, this is the correct period of adjustment for the delay. It is noted that the instant patent issued 3 years and 746 days after its filing date. However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, it was properly concluded that a total of 692 days overlapped. (The undersigned is unclear of patentees' basis for concluding that 327 days were non-overlapping). Thus, the additional non-overlapping period of 54 days was entered for Office delay in issuing the patent.

In view thereof, the patent term adjustment of 678 days indicated in the patent is correct.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" and last name "Johnson" clearly distinguishable.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions